

REMARKS

Claims 1-72 are pending and presented for examination in this application.

Applicants are amending claims 1, 3, 4, 14 and 47, 49, 50, and 60, canceling claims 2, 6, 7, 48 and 52-53, and withdrawing claims 26-46 and 62-72 with this Amendment and Response.

These changes are believed not to introduce new matter, and their entry is respectfully requested. In making these amendments, Applicants do not concede that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, Applicants reserve the right to pursue such protection at a later point in time and merely seek to pursue protection for the subject matter presented in this submission. Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Response to Restriction Requirement

Claims 1-72 are pending and subject to a restriction requirement under 35 USC § 121. The claims are restricted into two groups, Group I containing claims 1-25 and 47-61 and Group II containing 26-46 and 62-72. In a telephone interview on 10/27/2006, Applicants' representative, Brian Hoffman, provisionally elected Group I with traverse. Applicants hereby elect Group I, claims 1-25 and 47-61, with traverse and withdraw the claims in Group II.

Response to Rejection Under 35 USC § 101

In the 4th paragraph of the Office Action, the Examiner has rejected claims 47-61 under 35 USC § 101 as allegedly being directed to non-statutory subject matter. The Examiner alleges that the claims cover an intangible signal, and that signal claims are non-statutory.

Applicants have amended independent claim 47 to recite a “**tangible** computer-readable medium”. Applicants submit that this amendment limits independent claim 47 and dependant claims 48-51 and 54-61 to tangible statutory subject matter. Accordingly, withdrawal of the §101 rejection is respectfully requested.

Response to Rejection Under 35 USC § 102(e)

In the 5th and 6th paragraphs of the Office Action, the Examiner rejects claim 25 under 35 USC § 102(e) as allegedly being anticipated by U.S. Publication No. 2005/0065909 to Musgrove et al. (“Musgrove”). This rejection is respectfully traversed.

The Examiner has not carried the initial burden of showing that Musgrove is available as a prior art reference – a necessary element to the Examiner’s prima facie case of unpatentability. Musgrove was filed on August 5, 2004, after the March 31, 2004 filing date of the present application, but claims the benefit of U.S. provisional application 60/492,327 filed on August 05, 2003, before the filing of present application. In citing Musgrove, therefore, the Examiner incorrectly assumed that the reference is entitled to an earlier effective date.

Before the Examiner can accord Musgrove that earlier effective date, the Examiner must show that the subject matter relied on in the rejection is also found in the earlier parent application. A patent application that claims the benefit of a parent application may be accorded the earlier filing date as its effective date under 35 U.S.C. § 102(e) only if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application’s disclosure. See MPEP 706.02(f)(1) (instructing the Examiner, when determining the effective date of a reference, to consider benefit claims to prior applications under 35 U.S.C. 119(e) or 120 “if the prior application(s) properly supports the subject

matter used to make the rejection"). Because the Examiner has not shown that all the subject matter relied on in the rejection is in the parent application, Musgrove cannot be treated as prior art under 35 U.S.C. § 102(e).

Should the Examiner maintain this rejection based on Musgrove, Applicants request that any rejection based on Musgrove specifically identify (preferably by page and line number) the subject matter in the earlier provisional application - not the child utility application - that the Examiner asserts discloses the claimed invention. 37 C.F.R. § 1.104(c) (requiring the pertinence of each reference to be clearly explained).

To expedite the prosecution of this application it is noted that the provisional application to which Musgrove claims the benefit does not disclose or suggest the elements relied on in the rejection. In the rejection of claim 25, the Examiner relies upon Paragraphs 16 and 26 of Musgrove.

The examiner asserts that the element of claim 25 reciting "**identifying an aspect associated with an article**" is disclosed in Paragraph 16 of Musgrove. Paragraph 16 discloses a sequential method of keyword determination by word score frequency adjustment. The material within Paragraph 16 of the utility application is not disclosed within the provisional application. The provisional application discloses that the keywords are "*derived from*" foregoing parsing and analysis steps. The provisional application does not explicitly disclose a method for keyword determination using word score frequency adjustment as recited in Musgrove's utility application. Therefore, the provisional application does not support the the Examiner's rejection of this claim element based on matter found in the utility application.

The Examiner asserts that the elements of claim 25 reciting “**automatically searching a local article index with a user context dependant search query**” and “**automatically generating an insert comprising the search result**” are disclosed in Paragraph 26 of Musgrove’s utility application. Paragraph 26 describes a sequential method of product database searching containing parsing and score updates as post-processing steps from a database search using a keyword query search string. However, Musgrove’s provisional application fails to disclose assigning a score to identified products prior to post processing and updating the score based on an adjusted word score. The provisional application also contains no disclosure of parsing as a post-processing step or parsing in specific reference to the product records. Thus, Applicants request that the rejection of claim 25 be withdrawn because these aspects of Musgrove’s utility application are not disclosed in the provisional application.

Response to Rejection Under 35 USC 103(a)

In the 7th and 8th paragraphs of the Office Action, the Examiner rejects claims 1-8, 11-24, 47-54 and 57-61 under 35 USC § 103(a) as allegedly being unpatentable over U.S. Patent No. 6, 976, 053 to Tripp et al. (“Tripp”) in view of Phelps. This rejection is respectfully traversed.

Claims 1 and 47, as amended, respectively recite a method and computer readable medium comprised of the following features:

generating a user-context-dependent search query based, at least in part, on a user action history comprising **a plurality of user actions associated with a plurality of articles**;

identifying an aspect associated with an article; and

generating an insert based, at least in part, on the aspect, wherein the insert comprises a search result associated with the aspect and generated responsive, at least in part, to searching an article index using the user context-dependant search query.

The limitation related to “generating a user context dependant query at least in part, on a user action history comprising a plurality of user actions” was previously recited in cancelled claims 2, 6, 7, 52 and 53.

The claimed invention provides the benefit of using a user action history comprised of a plurality of user actions associated with a plurality of articles to generate user-context-dependant search queries. As outlined in Paragraphs 68 and 78 of the Applicants’ specification, the history of interactions with articles provides information which may be used to provide additional user-context in searches.

Neither Tripp nor Phelps discloses or suggests using a user action history comprising a plurality of user actions **with a plurality of articles**, as claimed. Tripp discloses a bottom-up system for creating a searchable index from the content of a network with agents local to each host computer. In Tripp, conceptual and non-keyword information is utilized to create a centralized catalog in order to improve search accuracy. As noted by the Examiner in the rejections of claims 7 and 53, Tripp does not disclose that a user–context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions.

The Examiner asserts that this claim element is disclosed in Phelps. However, Applicants respectfully submit that Phelps does not disclose or suggest using a user action history comprising a plurality of user actions **with a plurality of articles**, as now claimed. Phelps generally describes additional features of the same product described in Tripp. The Examiner asserts that the claim element at issue is disclosed by Phelps at Page 5, Paragraph 8 and Page 9, Paragraph 1. This portion of Phelps describes how a user can modify a search program by selecting among different customization options it offers. In the rejection, the

Examiner asserts that selection of user options comprises a “user action history comprised of a plurality of user actions”.

However, selecting a program option is not equivalent to “a plurality of user actions with a plurality of articles” as recited by the amended claims. As outlined, e.g., in paragraphs 13-14 of Applicants’ specification, articles include word processor documents, emails, messages, media files, etc. Thus, selecting a program option as disclosed in Phelps does not teach or suggest using a plurality of user actions with a plurality of articles as claimed.

Musgrove does not remedy the deficiencies of Tripp or Phelps. Accordingly, Applicants respectfully submit that a person of ordinary skill in the art, considering the teachings of Tripp and Phelps (and Musgrove) would not have found the invention of claims 1 and 47 obvious. The dependent claims not mentioned above incorporate the limitations of their respective base claims and are not obvious for at least the same reasons.

Conclusion

In sum, Applicants respectfully submit that the pending claims are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them. In addition, Applicants respectfully invite the Examiner to contact Applicants’ representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,
David B. Auerbach et al.

Date: March 7, 2007 By: /Brian Hoffman/

Brian M. Hoffman, Reg. No. 39,713
Attorney for Applicant
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel.: (415) 875-2484
Fax: (415) 281-1350